REMARKS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1-28 are presently active in this case.

Claims 1-28 were rejected under 35 U.S.C. §103(a) as unpatentable over Satoh (U.S. Patent No. 5,276,875) in view of Fantozzi (U.S. Patent No. 3,813,157).

In response to the rejection of Claims 1-28 under 35 U.S.C. §103(a), Applicant respectfully requests reconsideration of this rejection and traverses the rejection, as discussed next.

Briefly recapitulating, Applicant's Claim 1 relates to an image processing apparatus, including a scanner with a direct control section configured to control a scanning operation of the scanner so as to input image information from an original document; and a main body configured to process the image information, and including a control section configured to perform an initializing process for the main body, wherein a homing operation of the scanner is performed by the direct control section independently of the initializing process of the control section of the main body, when power is supplied to the image processing apparatus or when the image processing apparatus is returned from a shutdown state, and wherein a warm-up of the main body is started when a completion of the homing operation of the scanner is confirmed. Independent Claims 2-3, 5, 15-17 and 19 recite similar features in the context image processing apparatuses, independent Claims 8-10 and 12 recite similar features in the context of a method for initializing an image processing apparatus, and independent Claims 22-24 and 26 recite similar features in the context of a computer program product for initializing an image processing apparatus.

To facilitate the understanding of the Applicants' invention, the present invention as disclosed in the Specification is next explained. In the claimed image processing apparatus,

the homing operation of the scanner is performed by the direct control section of the scanner in parallel with initializing processes of the main body.[1] Subsequently, the apparatus confirms if the homing operation of the scanner was performed normally.[2] If the homing operation of the scanner was performed normally, the scanner is automatically adjusted and the main body is warmed up.[3]

As explained in Applicant's Specification at page 3, lines 1-17 with corresponding Figures 2 and 5, Applicant's invention improves upon background image processing apparatuses, since a method and a computer program product can perform the initialization process of the scanner in a short time period. In particular, the time required for the initialization process of the image processing apparatus can be reduced after the apparatus is turned on or after the apparatus returns to operation from a shutdown state.

Turning now to the applied references, Satoh discloses a state control system for a copying machine to work in a sequence of processing operations divided into a plurality of states, wherein a position for starting a document reading can be determined by driving the imaging unit for one time in advance to detect the position of the register and the home position.[4] Satoh, however, fails to teach or suggest Applicant's claimed image processing apparatus. In particular, and as acknowledged by the outstanding Office Action,[5] Satoh fails to teach or suggest that the warm-up of the main body is started when a completion of the homing operation of the scanner is confirmed, as claimed.

The outstanding Office Action rejects Applicant's Claims 1-28 based on the proposition that Fantozzi discloses the above feature,[6] and that it would have been obvious to modify Satoh by importing this feature from Fantozzi to arrive at Applicant's claimed

[1] See Applicant's Figure 5, steps 12 and 13.
[2] See Applicant's Figure 5, step 14.
[3] See Applicant's Figure 5, steps 15 and 16.
[4] See Satoh in the Abstract, and at column 11, lines 5-15, and in Figure 5(b).
[5] See outstanding Office Action at page 3, lines 11-12.
[6] See outstanding Office Action from page 3, lines 13-14.

invention. Applicant respectfully submits, however, that Fantozzi fails to disclose the above feature that the warm-up of the main body is started when a completion of the homing operation of the scanner is confirmed, as next discussed.

The outstanding Office Action relies on Fantozzi's text at column 9. This passage of Fantozzi recites at column 9, lines 17-32 "[a]fter the print button is pressed, at time t_0 (FIG. 8C) and after a duration of warm up time Δ_t, a scan pulse S1 is generated by the actuation of the scan switch 33 as the scanning means 13 begins to drive away from its rest position, the scan switch 33 is deactuated thereby removing the scan pulse." Fantozzi further explains that the apparatus opens and closes the homing switch 33 in a regular time interval, in synchronization with each scan cycle, to key the timing signals for monitoring or controlling various elements.[7] In other words, the scanner is first warmed-up, and subsequently the scanner is moved from its home position to perform synchronization of timing. Reading Fantozzi, a person of ordinary skill in the art would understand that warming up the scanner first and then operating the homing switch by the scanner to key the timing, ***is not*** starting warming-up of the main body when a completion of the homing operation of the scanner is confirmed,[8] as would be required to meet Applicant's claimed feature. Therefore, even if the combination of Satoh and Fantozzi is assumed to be proper, the combination fails to teach every element of the claimed invention. Specifically, the combination fails to teach that the claimed warming-up of the main body is started when a completion of the homing operation of the scanner is confirmed. Accordingly, Applicant respectfully traverses, and requests reconsideration of, this rejection based on these patents.[9]

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[7] See Fantozzi from column 3, line 60 to column 4, line 11 and in corresponding Figure 5.
[8] See Fantozzi, for example, at column 9, lines 17-32.
[9] See MPEP 2142 stating, as one of the three "basic criteria [that] must be met" in order to establish a *prima facie* case of obviousness, that "the prior art reference (or references when combined) must teach or suggest all the claim limitations," (emphasis added). See also MPEP 2143.03: "All words in a claim must be considered in judging the patentability of that claim against the prior art."

Applicant also respectfully traverses the obviousness-type rejection based on Satoh and Fantozzi because there is insufficient evidence for a motivation to modify Satoh by incorporating Fantozzi's homing switch 33 for timing synchronization, for the following reasons.[10]

It is not clear from the record how the teaching of Fantozzi's homing switch 33 for the scanning means 13 could be incorporated into Satoh. Satoh's copying machine includes an image input terminal IIT 32 with an imaging unit 37 for scanning the documents and an image output terminal IOT 34 with a scanner 40 to provide a photosensitive image to the belt 41.[11] Therefore, Satoh has two different types of scanning units, one for image input, and one for image output. Fantozzi, however, only uses one scanning device 13 to scan the document 11 and also to provide a photosensitive image to the drum 1,[12] thereby using analog signals to copy the document. Since in Fantozzi image input scanning and output scanning is not done by two different units with a digital data transmission, the homing switch 33 is required to synchronize the entire process of copying document. Satoh does not need such a feature, since these processes are separated into IIT 32 and IOT 34 and are performed with a digital control circuit.[13]

Further, it is not clear from the references of record how the teachings of Fantozzi's homing switch 33 could be incorporated into Satoh's IIT 32 or IOT 34. Such modification would require a substantial reconstruction or redesign of the elements of Satoh, and would

[10] See MPEP 2143.01 stating "[o]bviousness can only be established by combining or modifying the teaching of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art," (citations omitted). See also MPEP 2144.08 III stating that "[e]xplicit findings on motivation or suggestion to select the claimed invention should also be articulated in order to support a 35 U.S.C. 103 ground of rejection. . . Conclusory statements of similarity or motivation, without any articulated rational or evidentiary support, do not constitute sufficient factual findings."

[11] See Satoh from column 4, line 34 to column 5, line 33 and in corresponding Figure 2.

[12] See Fantozzi at column 3, lines 19-64 and in corresponding Figure 2.

[13] See Satoh in Figure 3.

change the basic principle of operation of Satoh. There is no evidence that a person of ordinary skill in the art would be motivated to perform such changes and redesign.[14]

In rejecting a claim under 35 U.S.C. §103(a), the U.S.P.T.O. must support its rejection by "substantial evidence" within the record,[15] and by "clear and particular" evidence[16] of a suggestion, teaching, or motivation to combine the teachings of different references. As discussed above, there is no substantial evidence, nor clear and particular evidence, within the record of motivation for modifying Satoh by incorporating Fantozzi's homing switch. Without such motivation and absent improper hindsight reconstruction,[17] a person of ordinary skill in the art would not be motivated to perform the proposed modification, and Claims 1-28 are believed to be non-obvious and patentable over the applied references.

Consequently, in view of the present request for reconsideration, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 1-28 is earnestly solicited.

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[14] See In re Ratti, 270 F.2d 810, 813, 123 USPQ 349, 352 (reversing an obviousness rejection where the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate.")

[15] In re Gartside, 203 F3d 1305, 53 USPQ2d 1769 (Fed. Cir. 2000) (holding that, consistent with the Administrative Procedure Act at 5 USC 706(e), the CAFC reviews the Board's decisions based on factfindings, such as 35 U.S.C. § 103(a) rejections, using the 'substantial evidence' standard because these decisions are confined to the factual record compiled by the Board.)

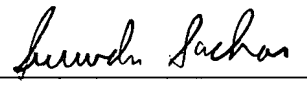
[16] In re Dembiczak, 175 F3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, although 'the suggestion more often comes from the teachings of the pertinent references.' The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular.") (emphasis added).

[17] See MPEP 2141, stating, as one of the tenets of patent law applying to 35 USC 103, that "[t]he references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention."

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicant's undersigned representative at the below listed telephone number.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Gregory J. Maier
Attorney of Record
Registration No. 25,599

Surinder Sachar
Registration No. 34,423

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

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